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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/989,448	11/21/2001	Adrian Velthuis	08011.3012-00	1416
7590	02/23/2005		EXAMINER	
Finnegan, Henderson, Farabow, Garrett & Dunner, L.L.P. 1300 I Street, N.W. Washington, DC 20005-3315			CARLSON, JEFFREY D	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	09/989,448	VELTHUIS ET AL.	
	Examiner	Art Unit	
	Jeffrey D. Carlson	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-11 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.



Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/24/02
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 6 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 4 requires sending a coupon to an identified computer as requested by a user; it is not clear how the step of coupon transmission to an identified computer can include the step of printing the coupon.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-11 are rejected under 35 U.S.C. 101 because they do not provide a useful, concrete and tangible result. The claim concludes with showing the coupon to a retailer. The "to redeem" language is not taken to be positively set forth and is merely taken to provide preparatory steps in order that the redemption may occur. Applicant

should include the positive step of retailer redemption in order to accomplish the required useful, concrete and tangible result.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1, 3, 9, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mankoff et al (US6385591) in view of DeLuca et al (US5870030).**

Regarding claims 1, 3, 9, 11, Mankoff et al teaches the concept of a user browsing webpages on the Internet and clicking a banner advertisement to request an electronic coupon be delivered (from a coupon server) to his computer. Mankoff et al teaches that the coupon can be redeemed at a retailer by synchronizing (connecting) the computer to the retailer computer and transferring the coupon to the retailer. It is not clear to what extent the coupon to be redeemed is displayed to a retailer, however the examiner is relying on DeLuca et al for such display (to then redeem). DeLuca et al teaches electronic coupons that are stored in a portable device. DeLuca et al teaches that the portable coupon device may display a text coupon or barcode coupon in order for a retailer clerk to visually redeem the coupon – by way of optically scanning or by simple visual inspection [col 10 lines 55+]. It would have been obvious to one of ordinary skill at the time of the invention to have displayed the electronic coupons of

Mankoff et al on the portable device in order to allow redemption by scanning or by simple inspection. The display of a text coupon is taken to be display of a subset of the coupon data (i.e. barcode data is not displayed) to accommodate a text-only display.

5. Claims 2, 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mankoff et al in view of DeLuca et al and Golden et al (US57616448). Mankoff et al does not teach limiting the number of coupons to be downloaded to the user device. Golden et al also teaches downloading electronic coupons to a user computer. Golden et al provides a feature whereby the user may download only a certain number of coupons [col 4 lines 2-8]. It would have been obvious to one of ordinary skill at the time of the invention to have enabled such a provision of a predetermined maximum number of coupons that can be downloaded to the user's device. Such a feature would help prevent coupon fraud, for example.

6. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mankoff et al in view Sim (KR2000030358A). Sim (KR2000030358A) is a document that was published June 5, 2000. The WO 01/63507 A1 document has been included merely as an English-language equivalent of Sim (KR2000030358A) and will be used to reference portions of Sim's disclosure which support the examiner's conclusions.

Regarding claims 4, 5, Mankoff et al teaches delivery of electronic coupons to user devices such as PDA's, smart watches Internet appliances and other devices [col 3 lines 35-39]. Mankoff et al does not teach delivery to wireless phones. Sim

(KR2000030358A) teaches delivery of electronic coupons to wireless phone users [pg 3] and it would have been obvious to one of ordinary skill at the time of the invention to have delivered the coupons of Mankoff et al to user's phones as an alternative portable coupon device. Sim (KR2000030358A) teaches that a database is provided on coupon server 6 which stored user's phone numbers so that coupons can be delivered to a particular identified user phone. It would have been obvious to one of ordinary skill at the time of the invention for the user to have inputted/provided his wireless phone number (or other wireless identifier) to the system so that his phone can be correctly identified in the database responsible for delivering the coupons. Mankoff et al teaches that the site that provides the coupon-associated advertising may be a different server than the one which ultimately delivers the coupon to the identified user [col 2 lines 7-20, col 3 lines 50 to col 4 line 12, FIG 4]. The coupon is taken to be a purchasing incentive.

Regarding claim 6 as best understood, Mankoff et al teaches that it is well known to receive electronic coupons and print them [col 1 lines 28-35].

7. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mankoff et al in view Sim (KR2000030358A) and DeLuca et al. Sim (KR2000030358A) is a document that was published June 5, 2000. The WO 01/63507 A1 document has been included merely as an English-language equivalent of Sim (KR2000030358A) and will be used to reference portions of Sim's disclosure which support the examiner's conclusions.

Regarding claims 7, 8, It is not clear to what extent Mankoff et al's coupon to be redeemed is displayed to a retailer, however the examiner is relying on DeLuca et al for such display (to then redeem). DeLuca et al teaches electronic coupons that are stored in a portable device. DeLuca et al teaches that the portable coupon device may display a text coupon or barcode coupon in order for a retailer clerk to visually redeem the coupon – by way of optically scanning or by simple visual inspection [col 10 lines 55+]. It would have been obvious to one of ordinary skill at the time of the invention to have displayed the electronic coupons of Mankoff et al on the portable phone device of Sim (KR2000030358A) in order to allow redemption by scanning or by simple inspection.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Kim (KR2002014169 A) teaches users connecting to a server and requesting that coupon(s) be sent to them via their identified wireless telephone number.
- Sim (KR2000030358 A) also teaches electronic coupons sent to wireless phones.
- Greenberg et al (WO 00/39657) teaches electronic coupons delivered to user's cell phones.
- Emodi et al. (2002/0016748 A1) and Strickland, George G. (2002/0027978 A1) also teach delivery of electronic coupons to phones.

The examiner will have a new telephone number (571-272-6716) effective April 14, 2005. The examiner's old telephone number (703-308-3402) will remain active until June 14, 2005. Similarly, the telephone number for the examiner's supervisor (Eric Stamber) will change from 703-305-8469 to 571-272-6724.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 703-308-3402. The examiner can normally be reached on Mon-Fri 8:30-6p, (off on alternate Fridays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey D. Carlson
Primary Examiner
Art Unit 3622
